

### **REMARKS/ARGUMENTS**

The rejection presented in the Office Action dated June 1, 2007 (hereinafter Office Action) has been considered but is believed to be improper because correspondence to each of the claimed limitations has not been identified in the requisite detail to support a §102 rejection. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses the §102(b) rejection based upon U.S. Patent No. 5,558,339 to Perlman (hereinafter “Perlman”) because Perlman does not teach or suggest each of the claimed limitations. For example, Perlman has not been shown to teach a gaming device sending a gaming request to another gaming device containing an invitation to play a game, as claimed in each of the independent claims. Rather, Perlman teaches away from the need for such a procedure as the server 122 has already identified that both users want to play and matches them using this information (column 21, lines 32-61) before communication occurs between the two users’ gaming devices. None of the cited portions of Perlman teaches sending an invitation to play a game via a request from one gaming device to another. Without a presentation of correspondence to each of the claimed limitations, the §102(b) rejection is improper.

Applicant notes that to anticipate a claim the asserted reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.* every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain the rejection based on 35 U.S.C. §102. Applicant respectfully submits that Perlman does not teach every element of independent Claims 1, 15, 16, 19 and 23 in the requisite detail and therefore fails to anticipate Claims 1-28.

Moreover, Perlman also has not been shown to teach a device having memory to store contact information of at least one user of another device where the information includes data about the multiplayer capable games supported by the other device, as claimed in independent Claims 1, 15, 19 and 23. In contrast, Perlman teaches that a first user's computer obtains contact information about a second user from the server 122 (column 21, line 58 – column 22, line 12). There is no indication that such information is stored in the first user's computer or that the contact information includes information on games that are supported by the second user's equipment. Without a presentation of correspondence to each of the claimed limitations, the §102 rejection is improper. Applicant accordingly requests that the rejection be withdrawn.

In addition, dependent Claims 2-14, 17, 18, 20-22 and 24-28 depend from independent Claims 1, 19 and 23, respectively, and also stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Perlman. While Applicant does not acquiesce to the particular rejection to these dependent claims, the rejection is also improper for the reasons discussed above in connection with independent Claims 1, 19 and 23. These dependent claims include all of the limitations of independent Claims 1, 19 and 23 and any intervening claims, and recite additional features which further distinguish them from the cited reference. Therefore, the rejection of dependent Claims 2-14, 17, 18, 20-22 and 24-28 is improper. Applicant accordingly requests that the §102(b) rejection be withdrawn.

With particular respect to the various dependent claims, the Office Action has not identified where Perlman teaches several of the claimed limitations. More specifically, it has not been shown where Perlman at least teaches the claim limitations directed to: predetermined time limits for receiving responses (*e.g.*, Claims 6 and 8), an event log stored in the device (*e.g.*, Claim 7), blocking gaming requests (*e.g.*, Claim 10), and the communication unit comprising a terminal of a cellular radio system, infrared transceiver or short-range radio transceiver (*e.g.*, Claims 11-13). Without a presentation of correspondence to each of the claimed limitations, the rejection is improper, and Applicant requests that it be withdrawn.

With respect to the objection to the Declaration filed on April 12, 2004, the objection appears to be without basis. The filed Declaration states in part “I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, § 1.56 (attached hereto).” While the objection appears to be based on the presence of the word “the” preceding the word “patentability”, the Office Action does not explain why inclusion of the word “the” would render the declaration defective. Although the Office Action suggests that specific and exact language should be used in a declaration, none of the cited portions of the MPEP or CFR include such a requirement. It is also noted that 37 CFR 1.56 itself recites “material to the patentability” amongst recitations of “material to patentability.” Accordingly, Applicant submits that 37 CFR 1.56 recognizes “material to the patentability” as an acceptable phrase for the purpose of acknowledging the disclosure duty of 37 CFR 1.56. In addition, since the filed Declaration reprints 37 CFR 1.56, the filed Declaration makes perfectly clear what duty is being acknowledged, fulfilling both the spirit and letter of the 37 CFR 1.63(b)(3) requirement of including a signed oath/declaration of acknowledgement of the duty of disclosure. Thus, the filed Declaration is not believed to be defective.

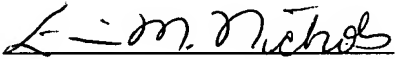
Although Applicant traverses the objection as being improper, in an effort to facilitate prosecution a Supplemental Declaration has been executed and is attached to this response. Therefore, the objection is believed to be overcome, and Applicant requests that it be removed.

Authorization is given to charge Deposit Account No. 50-3581 (NKO.024.A1) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC  
8009 34<sup>th</sup> Avenue South, Suite 125  
Minneapolis, MN 55425  
952.854.2700

Date: August 28, 2007

By: 

Erin M. Nichols  
Reg. No. 57,125